UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

MAY 03 2007

OFFICE OF PETITIONS

SENNIGER POWERS
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS MO 63102

In re Application Of :
Anderson, et al. : DECISION ON APPLICATION
Application No. 10/039,236 : FOR
Filed: December 31, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. KCC 4779 :

This is a decision on the "LETTER TO THE PATENT AND TRADEMARK OFFICE", filed March 14, 2007, which is being treated as an application for patent term adjustment under 37 C.F.R. §1.705(b). Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to two hundred forty-six (246) days.

The application for patent term adjustment is **DISMISSED**.

On January 8, 2007, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On March 14, 2007, applicants timely filed the instant application for patent term adjustment, asserting that the correct patent term at the time of mailing of the Notice of Allowance is two hundred forty-six (246) days.

Applicants assert entitlement to a patent term adjustment of two hundred forty-six (246) days on the basis that the PTO improperly assessed Applicants a delay of two hundred forty-six (246) days for responding to a March 17, 2003 Office action on February 18, 2004. Applicants assert that they timely filed a response on June 16, 2003. In addition, applicants assert that the PTO should have been assessed delay for not responding to applicants'

June 16, 2003 reply until July 12, 2004. Lastly, applicants claim that they should not have been assessed delay of forty-nine (49) and twenty-six (26) days for filing supplemental replies (Information Disclosure Statements) on September 26, 2005 and February 20, 2006.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of four hundred two (402) days based on an adjustment for PTO delay of zero days, reduced by Applicant's delays of twenty-four (24) days and two hundred forty-six (246) days pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704(b), fifty-seven (57) days pursuant to 35 U.S.C. 154(b)(2)(C)(1) and 37 C.F.R. 1.704(c)(7), and forty-nine (49) and twenty-six (26) days pursuant to 35 U.S.C. 154(b)(2)(C)(1) and 37 C.F.R. 1.704(c)(8). The adjustments of 246, 57, 49, and 26 days are at issue.

Applicants are correct that they should not have been assessed two hundred forty-six (246) days of delay for filing an amendment on February 18, 2004. As pointed out in the decision withdrawing the holding of abandonment mailed on March 1, 2004, applicants timely filed the amendment on June 16, 2003. Accordingly, no applicant delay should have been assessed with respect to this filing.

The next Office communication mailed in response to the June 16, 2003 amendment was a Notice of Non-Compliant Amendment, mailed on April 6, 2004. As this was more than four months after applicants' amendment, the PTO should have been assessed one hundred eighty-two (182) days of Office delay pursuant to 37 C.F.R. 1.703(a)(2).

Applicants responded to the Notice of Non-Compliant Amendment on April 15, 2004. Applicants contend that they should not have been assessed any delay pursuant to 37 C.F.R. 1.704(c)(7), because their response as originally submitted on June 16, 2003 was fully responsive according to the requirements of amendment practice under 37 C.F.R. § 1.121 pending at the time. Thus, applicants maintain that there were no circumstances constituting a failure by the Applicant to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704.

37 C.F.R. § 1.704(c)(7) provides that:

> Submission of a reply having an omission (§1.135(c))[1], in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

Petitioner's arguments are not persuasive. By Notice mailed April 6, 2004, applicants were advised that their earlier amendment reply was a non-compliant amendment. A review of the amendment finds the amendment was not compliant with rule 1.121 or the voluntary revised amendment practice, that was in effect at that time, because the withdrawn claims did not include the text. The Notice was proper given applicants' submission of the amendment under voluntary revised amendment practice. Therefore, on April 15, 2004, applicants filed a supplemental response, correcting the items deemed non-responsive by the examiner. Accordingly, the period of reduction should have been calculated as three hundred four (304) days, the number of days in the period beginning on June 17, 2003 and ending on April 15, 2004.

Lastly, applicants' arguments that they should not have been assessed applicant delay of 49 and 26 days for filing supplemental IDSs on September 26, 2005 and February 20, 2006 has been considered, but is not persuasive. 37 C.F.R. § 1.704(d) states that an IDS will not be considered a failure to engage under (c)(8) if it is accompanied by a statement that "each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by an individual in 1.56(c) more than thirty days prior to the filing" of the IDS.[2] The IDSs filed on September 26, 2005 and February 20, 2006 did not contain a proper 37 C.F.R. § 1.704(d) statement. Accordingly, applicant delay with respect to these filing was correctly assessed as 49 and 26 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is zero (0) days (182 days of PTO delay, reduced by 403 (24+304+49+26) days of applicant delay).

---

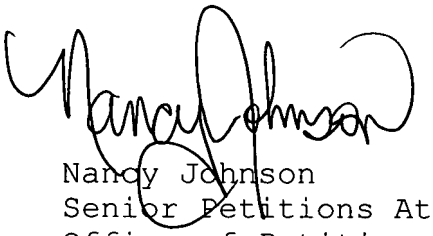
[1] §1.135(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[2] Emphasis added.

The $200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 19-1345, notwithstanding applicants' request that no fee be charged.[3]

The Office will forward the file to the Office of Patent Publication for issuance of the patent in a timely manner.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

[3] See Comment 1 in Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 1239 OG 14, 65 Fed. Reg. 54366 (Oct. 3 2000) (stating that the fee set forth in 37 C.F.R. 1.18(e) is charged to allow the Office to recover the estimated average cost of treating applications for patent term adjustment, and is not refundable even in the event of Office error).